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10/657,636	09/08/2003	Frank C. Nicholas	7710/10	2816

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EXAMINER	
DURAN, ARTHUR D	
ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/657,636	NICHOLAS ET AL.	
	Examiner	Art Unit	
	Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 September 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 14-33 have been examined.

Response to Amendment

The Amendment filed 9/20/10 on is sufficient to overcome the prior rejection. However, a new rejection has been made. Please note the addition of the Wycoff reference.

Election/Restrictions

On 12/18/09 Applicant elected Group III, claims 14-20. See Applicant Remarks dated 12/18/09 and 9/20/10.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 14, and its dependent claims, is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to a particular machine or apparatus (see at least *Diamond v.* Diehr, 450 U.S. 175, 184 (1981); *Parker v.* Flook, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v.* Benson, 409 U.S. 63, 70 (1972); *Cochrane v.* Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v.* Benson, 409 U.S. 63, 71 (1972)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. To correct this issue, the independent claim could be amended such that at

least one significant feature (not just data gathering or outputting) of the body of the claims actively uses a technological apparatus (computer, server, processor, etc).

Also, in regards to arguments concerning this 101 rejection made on 9/20/10, the 101 rejection still stands. The server is doing extra-solution activity such as data gathering or data output. The server is not doing active steps. The server is not doing active significant steps beyond routine data gathering or data output. If the server, or other hardware, were positively recited as doing active and significant steps, 101 would be satisfied.

Priority

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 10/172,492, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Parent CIP Application 10/172,492 does not disclose any Universal Resource Identifier (URI) or "invitation" as stated in the independent claim. Also, dependent claims 20 "ad wrapper" is not in 10/172,492. Hence, the priority date for the present application does Not benefit from 10/172,492.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14, 15, 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Gupta (6487538).

Claim 14. Gupta discloses a method of operating an online target advertising system, the method comprising:

Providing a page specific invitation to advertise link on a web page associated with its identifying universal resource identifier (URI);

Receiving a request to advertise via the link at an ad server;

Displaying an advertisement in an advertisement space on successive web pages having the identified URI, based on the request (11:15-25; 13:10-45; 14:20-35; Fig. 5).

Additionally, on 9/20/10, on page 8, Applicant states in regards to claim 14, "applicants respectfully request the Examiner expressly identify what element in Gupta is considered the page specific invitation to advertise link and what is the request made via the link."

And, Applicant's claim 14 states, "providing a page specific invitation to advertise link on a web page associated with its identifying universal resource identifier (URI); receiving a request to advertise via the link at an ad server;". Examiner notes the "receiving a request to advertise via the link at an ad server" feature. This feature can be interpreted as the request being made via the link or as the advertisement itself being via or associated with the link. Examiner interpreted the advertisement as being via the link. For example, the ad is associated with the link or the page which the ad is presented on. Hence, Examiner interprets these features as providing a page specific invitation to advertise on a webpage and a request to advertise using the ad link that is specific to a page. Examiner notes that Applicant did Not amend claim 14 on 9/20/10. However, Applicant did add new independent claims 22 and 28. And, for example, new claim 22 clarified the claim by adding , "receiving a request to advertise on the web page via selection of the link by a requesting advertiser". Hence, new claims 22 and 28 are interpreted as the link being used to request advertising. And, new claims 22 and 28 are rejected above using Gupta in view of Wycoff. However, unamended claim 14 is still interpreted as the link being used for the advertising.

And, Gupta discloses inviting advertisers to advertise on a specific webpage and providing the link and link information so the advertisers can advertise on the specific webpage (11:15-25; 13:10-45; 14:20-35; Fig. 5). Also, note in Gupta that URL information for the specific page that the ad is related to is provided (13:10-45; 14:20-35). Gupta further discloses that URL information for the specific page that the ad is

related to is provided (12:27-42; 16:27-35). Hence, Gupta discloses the currently unamended claim 14.

Claim 15. Gupta discloses the method of claim 14 wherein the price to occupy the advertisement space is determined in an ongoing auction (13:10-45).

Claim 19. Gupta discloses the method of claim 14 wherein the ad server is a right of first refusal ad server (Fig. 5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta (6487538).

Claims 21. Gupta does not explicitly disclose notifying an advertiser that has been displaced from the advertisement space that the advertisement space is available at a higher price. However, Gupta discloses displacing advertisements/advertisers and higher prices and that higher prices would make an ad space available or secures (14:34-48). And, Gupta discloses communications back and forth with the advertisers (Figs. 4a, 4b, 4c). Hence, it is obvious that the advertiser can be alerted when displaced or alerted that he can bid again to place an ad at new price. One would be motivated to do this to better provide advertising opportunities. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to

combine the features since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 16-18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta (6487538) in view of Gerace (5,848,396).

Claims 16-18: Gupta does not explicitly disclose, "16. The method of claim 14 further comprising collecting profile information based on the request to advertise.
17. The method of claim 14 wherein the profile information includes the identifying URI and the scanned contents of the web page having the identified URI.
18. The method of claim 14 further comprising providing a suggested URI based on the profile information" .

However, Gerace discloses profiling requests to advertise and advertisers (17:50-67; 11"64-12:6) and tracking the page and content where the ad came from (18:50-19:5; 6:55-7:25) and suggesting a URI (19:25-31). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gerace's tracking ad requests to Gupta's advertiser with ad requests and better targeting. One would have been motivated to do this in order to better improve ad targeting.

Claim 20. Gupta does not explicitly disclose wherein the advertisement displayed is selected from a targeted ad wrapper. Applicant's Specification describes targeted ad

wrapper at ([174]). Gerace discloses ads as series, campaigns, sets, or packages (12:20-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gerace's ad packages to Gupta's numerous ads . One would have been motivated to do this in order to better organize ad campaigns.

Claims 22-24, 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta (6487538) in view of Wycoff (20050021521).

Claims 22, 28. Please see the rejection of independent claim 14 above. Additionally, in regards to claims 22, Gupta does not explicitly disclose, the page specific invitation to advertise including a link for submission of a request to advertise... receiving a request to advertise on the web page via selection of the link by a requesting advertiser. And, in regards to claim 28, Gupta does not explicitly disclose wherein the page specific invitation to advertise link comprises means for directing an individual to a different web resource. However, Wycoff discloses the page specific invitation to advertise including a link for submission of a request to advertise... receiving a request to advertise on the web page via selection of the link by a requesting advertiser ([15, 78, 121]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Wycoff's providing links for requesting available ad space to Gupta's link's and offering available ad space. One would have been motivated to do this in order to better provide advertise and provide access to advertising opportunities. Alternatively, it would have

been obvious to one having ordinary skill in the art at the time of the invention to combine the features of the two inventions since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 23, 29. Gupta discloses the method of claim 14 wherein the price to occupy the advertisement space is determined in an ongoing auction (13:10-45).

Claims 24, 30. Gupta does not explicitly disclose notifying an advertiser that has been displaced from the advertisement space that the advertisement space is available at a higher price. However, Gupta discloses displacing advertisements/advertisers and higher prices and that higher prices would make an ad space available or secures (14:34-48). And, Gupta discloses communications back and forth with the advertisers (Figs. 4a, 4b, 4c). Hence, it is obvious that the advertiser can be alerted when displaced or alerted that he can bid again to place an ad at new price. One would be motivated to do this to better provide advertising opportunities. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the features since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 25-27, 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta (6487538) in view of Wycoff (20050021521) in view of Gerace (5,848,396).

Claims 25-27, 31-33. Gupta does not explicitly disclose, "16. The method of claim 14 further comprising collecting profile information based on the request to advertise. 17. The method of claim 14 wherein the profile information includes the identifying URI and the scanned contents of the web page having the identified URI.
18. The method of claim 14 further comprising providing a suggested URI based on the profile information" .

However, Gerace discloses profiling requests to advertise and advertisers (17:50-67; 11"64-12:6) and tracking the page and content where the ad came from (18:50-19:5; 6:55-7:25) and suggesting a URI (19:25-31). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gerace's tracking ad requests to Gupta's advertiser with ad requests and better targeting. One would have been motivated to do this in order to better improve ad targeting.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are not persuasive in regards to claim 14. Please note the following comments. Also, in regards to new claims, 21-33, the arguments are moot in view of the new ground(s) of rejection. Please see the addition of the Wycoff reference above and also the comments following.

On 9/20/10, on page 6, Applicant presented arguments concerning the 101 rejection. The 101 rejection still stands. Please see the comments added in the 101 rejection above.

On page 8, Applicant states in regards to claim 14, "applicants respectfully request the Examiner expressly identify what element in Gupta is considered the page specific invitation to advertise link and what is the request made via the link."

However, Examiner notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In interpreting claim language, the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art is applied, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description. See In re Morris', 127 F.3d 1048, 1054 (Fed. Cir. 1997). See also In ream. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364 (Fed. Cir. 2004) andIn re Sneed, 710 F.2d 1544, 1548 (Fed. Cir. 1983). Claims are given their broadest reasonable construction. See *In re Hyatt,* 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000). It is Appellant's burden to precisely define the invention. See In re Morris, 127 F.3d 1048, 1056 (Fed. Cir. 1997).

And, Applicant's claim 14 states, "providing a page specific invitation to advertise link on a web page associated with its identifying universal resource identifier (URI); receiving a request to advertise via the link at an ad server;". Examiner notes the

"receiving a request to advertise via the link at an ad server" feature. This feature can be interpreted as the request being made via the link or as the advertisement itself being via or associated with the link. Examiner interpreted the advertisement as being via the link. For example, the ad is associated with the link or the page which the ad is presented on. Hence, Examiner interprets these features as providing a page specific invitation to advertise on a webpage and a request to advertise using the ad link that is specific to a page. Examiner notes that Applicant did Not amend claim 14 on 9/20/10. However, Applicant did add new independent claims 22 and 28. And, for example, new claim 22 clarified the claim by adding , "receiving a request to advertise on the web page via selection of the link by a requesting advertiser". Hence, new claims 22 and 28 are interpreted as the link being used to request advertising. And, new claims 22 and 28 are rejected above using Gupta in view of Wycoff. However, unamended claim 14 is still interpreted as the link being used for the advertising.

And, Gupta discloses inviting advertisers to advertise on a specific webpage and providing the link and link information so the advertisers can advertise on the specific webpage (11:15-25; 13:10-45; 14:20-35; Fig. 5). Also, note in Gupta that URL information for the specific page that the ad is related to is provided (13:10-45; 14:20-35). Gupta further discloses that URL information for the specific page that the ad is related to is provided (12:27-42; 16:27-35). Hence, Gupta discloses the currently unamended claim 14.

In regards to claims 22, Gupta does not explicitly disclose, the page specific invitation to advertise including a link for submission of a request to advertise...

receiving a request to advertise on the web page via selection of the link by a requesting advertiser. And, in regards to claim 28, Gupta does not explicitly disclose wherein the page specific invitation to advertise link comprises means for directing an individual to a different web resource. However, Wycoff discloses the page specific invitation to advertise including a link for submission of a request to advertise... receiving a request to advertise on the web page via selection of the link by a requesting advertiser ([15, 78, 121]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Wycoff's providing links for requesting available ad space to Gupta's link's and offering available ad space. One would have been motivated to do this in order to better provide advertise and provide access to advertising opportunities. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the features of the two inventions since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Bell 20040125140 discloses to advertise link on a web page associated with its identifying universal resource identifier **(URI) (**Figs. 11a, 11b; [88]); Bell discloses a Figure with showing the empty/available ad slot **(**see the Figures 11a, 11b, item 1112);

Receiving a request to advertise via the link at an ad server;

Displaying an advertisement in an advertisement space on successive web pages having the identified URI, based on the request (Fig. 11b, item 1112).

b) Slaughter 7370091 discloses relevant features for filling empty ad slots.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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9/28/10